

APPLICANT(S): CARTER-SMITH, Michael et al.
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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1-6 and 8-14 are pending in the application. Claims 1-6 and 8-14 have been rejected. Claim 1 has been amended.

Claims 10-14 have been canceled without prejudice or disclaimer. In making this cancellation without prejudice, Applicants reserve all rights in these claims to file divisional and/or continuation patent applications.

Applicants respectfully assert that the claim amendment adds no new matter.

CLAIM REJECTIONS

35 U.S.C. § 112 Rejections

In the Office Action, the Examiner rejected claim 1-6, 8 and 9 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Examiner asserts that it is unclear how many visual indicators are claimed by the Applicants.

In response, Applicants followed the Examiner suggestion and amended Claim 1 to overcome the lack of clarity noted by the Examiner. It is respectfully asserted that the foregoing amendment merely addresses matters of form and does not change the literal scope of the claim in any way or result in any prosecution history estoppel.

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Applicants respectfully assert that this amendment render claim 1 proper under 35 USC 112 and request that the rejections be withdrawn. Accordingly, Applicants respectfully assert that amended independent claim 1 as amended is allowable. Claims 2-6, 8 and 9 depend from, directly or indirectly, claim 1 as amended, and therefore include all the limitations of that claim. Therefore, Applicants respectfully assert that claims 2-6, 8 and 9 are likewise allowable. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections to amended independent claim 1 and to claims 2-6, 8 and 9 dependent thereon.

35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 1-6 under 35 U.S.C. § 102(b), as being anticipated by JP 11028242 to Hirano (The '242 Patent). Specifically, the Examiner alleges that the '242 Patent describes an acupressure ring comprising two or more rings having a visual indicator when the ring is worn and a projection extending inwardly from an inner surface of said acupressure ring, the projection being approximately orthogonal to a visual indicator, wherein said visual indicator is provided by a break in said acupressure ring;

The '242 Patent does not teach or suggest "An acupressure ring for use on an outer finger, and comprising two or more rings having a visual indicator visible when the rings are worn on the outer finger and a projection extending inwardly from an inner surface of said acupressure ring, the projection being approximately orthogonal to the visual indicator, wherein said visual indicator is provided by a break in said acupressure ring." as recited in independent claim 1 as amended, from which claims 2-6 depend, either directly or indirectly, but is rather directed to acupressure device exclusively for the head. This is evident *inter-alia* in the title and figures cited by the Examiner rather than an acupressure ring for use on an outer finger as recited in claim 1 as amended.

It is well established, that in order to successfully assert a prima facie case of anticipation, the Examiner must provide a single prior art document that includes every element and limitation of the claim or claims being rejected. Since the '242 patent does not teach an acupressure ring for use on an outer finger, but rather exclusively for the head, the '242 patent fails to disclose all the elements of independent claim 1 as amended.

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Accordingly, Applicants respectfully assert that amended independent claim 1 is allowable. Claims 2-6 depend from, directly or indirectly, claim 1 as amended, and therefore include all the limitations of that claim. Therefore, Applicants respectfully assert that claims 2-6 are likewise allowable. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections to amended independent claim 1 and to claims 2-6 dependent thereon.

In the Office Action, the Examiner rejected claims 10 and 12 under 35 U.S.C. § 102(b), as being anticipated by US Patent No. 5,636531 to Miller (The '531 Patent).

In response, Applicants have cancelled Claims 10 and 12, making the rejection Moot. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections to Claims 10 and 12.

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 8 and 9 under 35 U.S.C. § 103(a), as being unpatentable over JP 11028242 to Hirano.

Applicants respectfully traverse the rejection of claims 8 and 9 under JP 11028242 to Hirano.

Applicants assert that the '242 Patent, does not teach or suggest, the invention of claims 1. The '242 Patent has been discussed above. That discussion is applicable here.

An obviousness rejection requires a teaching or a suggestion by the relied upon prior art of all the elements of a claim (M.P.E.P. §2142). Since the '242 Patent does not teach or suggest all the elements of independent claim 1, the Examiner fails to establish a prima facie showing that the '242 Patent, teach or suggest every feature of claim 1. Moreover, since the '242 Patent is directed exclusively to the head, there is no motivation for modifying the reference.

In the Office Action, the Examiner rejected claims 11, 13 and 14 under 35 U.S.C. § 103(a), as being unpatentable over US Patent No. 5,636531 to Miller. In response, Applicants have cancelled Claims 11, 13 and 14, making the rejection Moot. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections to Claims 11, 13 and 14.

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In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,


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